

REMARKS

Claims 6-15 and 26-31 were previously pending, of which claims 6, 26, 30, and 31 have been amended and claims 7 and 29 have been canceled without prejudice or disclaimer. Claims 32-37 have been added. Claims 8-15 remain in their original form. Reconsideration of presently pending claims 6, 8-15, 26-28, and 30-37 is respectfully requested in light of the above amendments and the following remarks.

Allowable Subject Matter

Noted with appreciation is the indication by the Examiner that claim 31 recites patentable subject matter, and would be allowable if rewritten in independent form. Claim 31 has been amended to depend from independent claim 26, which is believed to be allowable for the reasons set forth below. Accordingly, it is believed that it is unnecessary to separately place claim 31 in independent form at this time.

Claim Rejections Under 35 U.S.C. §103

Claims Claims 6-15 and 26-30 currently stand finally rejected under 35 U.S.C. §103(a) as being unpatentable over Noguchi et al. (US Patent No. 4,469,283 hereinafter referred to as "Noguchi"). As the PTO recognizes in MPEP §2142:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie case*, the applicant is under no obligation to submit evidence of nonobviousness.

Applicant respectfully submits that the Noguchi reference is defective in establishing a *prima facie* case of obviousness of claims 6-15 and 26-30 for the following mutually exclusive reasons.

A. The cited reference does not teach the claimed subject matter

As provided in MPEP § 2143, “[t]o establish a prima facie case of obviousness,...the prior art reference (or references when combined) must teach or suggest **all** the claim limitations.” (Emphasis added). Applicant respectfully submits that the rejection of claims 6 and 26 should be withdrawn at least because Noguchi does not meet this requirement.

The Examiner indicated that “the [previous] amendment to claim 6 is a functional limitation and does not further limit the apparatus.” (See Office Action, pg. 2). This “functional limitation” characterization by the Examiner has been clearly overcome by the foregoing amendments to claim 6 in which the pulverizing bone cutter has now been positively recited and has been limited in a structurally specific manner, “**wherein the pulverizing bone cutter is configured and operative to pulverize bone received into the first casing member in a manner making the pulverized bone suitable for use in a surgical procedure.**” Clearly, Noguchi does not teach or in any manner suggest the inclusion in a coffee grinder of any sort of a cutter which is configured and operative to pulverize bone in a manner making it suitable for use in a surgical procedure.

Claim 6 further specifies that the recited first casing member has an **opening** therein for receiving bone. In rejecting claim 6, the Examiner contends that it would have been obvious to modify Noguchi to provide for an opening in the upper portion of the coffee grinder. The Office Action indicated that “[c]oncerning the feed opening, it is noted that the opening proposed by the examiner in the cover of the [Noguchi] patent would allow the patented apparatus to function in the desired manner **since it is only necessary to have a small opening.**” (See Office Action, pg. 2). Applicant respectfully traverses this assertion. More specifically, claim 6 recites that the opening is “**for receiving bone into the first casing member**.” Accordingly, modifying Noguchi by providing an opening for receiving bone or other material would adversely affect the intended desire to provide an enclosed catching space for the coffee grinder. (See Noguchi, reference number 9 of Figs. 1, 4, and 7). Moreover, an opening located within the Noguchi

catching space would allow waste components “such as skin slivers and fine fragments of coffee beans” to escape from the coffee grinder and thus, would make Noguchi’s coffee grinder less desirable of its intended function. (See Noguchi, col. 2, lines 61-63). Therefore, it clearly would not have been obvious to modify Noguchi in the manner suggested by the Office Action.

For at least these reasons it is respectfully submitted that the Examiner has failed to establish the requisite *prima facie* case of obviousness of claim 6 using Noguchi. Therefore, the obviousness rejection of claim 6 based on Noguchi should be withdrawn.

Turning now to the merits of claim 26, when evaluating a claim for determining obviousness, all limitations of the claim must be evaluated. Noguchi clearly does not teach or suggest “[a]n automatic surgical mill, comprising: a first casing member, the first casing member having an opening for receiving bone into the first casing member...wherein the first casing member is substantially devoid of any operational structure other than the pulverizing bone cutter,” as recited in amended claim 26. In contrast, Noguchi teaches the positioning of a coffee bean waste component catching structure within the mill casing cover. (See Noguchi, reference number 9 of Figs. 1, 4, and 7). In fact, Noguchi states that it is an object of the present invention to provide “a coffee beans waste component catching space...in the mill casing” to automatically separate waste components from usable components of the coffee beans during the milling process. (See Noguchi, col. 1, lines 29-48). Thus, it is a necessity in the Noguchi coffee grinder to position in the interior of the upper chamber a substantial operational structure in addition to the coffee grinding blade.

For at least these reasons it is respectfully submitted that the Examiner’s burden of factually supporting a *prima facie* case of obviousness has not been met and the obviousness rejection of claim 26 under 35 U.S.C. §103(a) should be withdrawn.

B. The cited reference teaches away from the claimed subject matter

There is still another compelling, and mutually exclusive reason why the Noguchi patent cannot properly be applied to reject independent claims 6 and 26 under 35 U.S.C. §103(a).

In the present case the Noguchi reference, by providing an “**air flow producing means in said mill casing for producing air flow** passing between said cutter receiving space and said waste component catching space,” clearly teaches away from a limitation in claim 6. (See Noguchi, col. 7, lines 62-65). Claim 6 recites in part, “An automatic surgical mill for pulverizing bone, comprising: a first casing member, **the first casing member having an opening for receiving bone into the first casing member.**” Therefore, an opening in the mill casing cover of Noguchi would adversely affect the intended function of air flowing between the cutter receiving space and the waste component catching space. (See generally Noguchi, col. 3, lines 36-61). Furthermore, as previously mentioned herein, the opening would allow waste components such as skin slivers and fine fragments of coffee to escape from the grinder.

Additionally, the Noguchi reference, by providing an “a mill casing defining a cutter receiving space and **a coffee bean waste component catching space[] formed above said receiving space,**” clearly teaches away from the claimed subject matter of amended claim 26. (See Noguchi, col. 7, lines 55-57). The coffee bean waste component catching space is a necessary and operational structure of the mill casing cover in Noguchi. However, claim 26 recites in part, “**wherein the first casing member is substantially devoid of any operational structure other than the pulverizing bone cutter.**” Therefore, the Noguchi patent clearly teaches away from amended claim 26.

Since it is well recognized that teaching away from the claimed invention is *per se* demonstration of lack of *prima facie* obviousness, it is clear that the Examiner has not borne the initial burden of factually supporting any *prima facie* case of obviousness. Thus, for this additional reason, the rejection of claims 6 and 26 under 35 U.S.C. §103(a) should be withdrawn.

Dependent Claims

Claims 8-15 depend from and further limit claim 6 and should be allowable for at least the same reasons as set forth above for claim 6.

Claims 27, 28, 30, and 31 depend from and further limit claim 26 and should be allowable for at least the same reasons as set forth above for claim 26.

New Claims

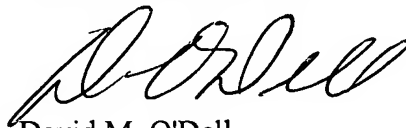
Claims 32-37 have been added. Claims 32-36 depend from and further limit, directly or indirectly, claim 6 and should be allowable for at least the same reasons as set forth above for claim 6. Claim 37 depends from and further limits claim 26 and should be allowable for at least the same reasons as set forth above for claim 26. No new matter has been added via these new claims.

Conclusion

It is clear from all of the foregoing that independent claims 6 and 26 are in condition for allowance. Dependent claims 8-15, 27, 28, 30-37 depend from and further limit independent claims 6 and 26, and therefore are allowable as well.

An early formal notice of allowance of claims 6, 8-15, 26-28, and 30-37 is requested. The Examiner is invited to call the undersigned at the below-listed number if a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,



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